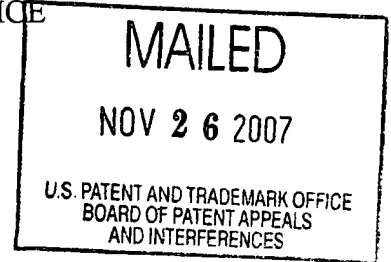


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte: TIMOTHY MCDONOUGH, CARL LEDBETTER, ROBERT PLANK,
STEVEN FISHER, STEVEN KANEKO AND STEVEN BATHICHE

Application No. 09/699,517

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on November 19, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

APPEAL BRIEF

Summary Of Claimed Subject Matter

Appellant filed an Appeal Brief dated February 28, 2007, in response to the Notification of Non-Compliant Appeal Brief mailed January 30, 2007. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

37 CFR § 41.37(c) states in part:

(v) ***Summary Of Claimed Subject Matter***. A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

The “Summary of claimed subject matter” appearing on page 2-4 of the Appeal Brief filed February 28, 2007, is deficient because it does not separately map independent claims 35, 37, 39-44, 49, 50 and 52 to the specification.

When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

EXAMINER’S ANSWER

In the Examiner’s Answer mailed May 3, 2007, the Examiner rejected claim 43 under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Suzuki et al. (USPN5890139). It is noted that the Suzuki reference has not been listed in the Evidence Relied Upon section.

CONCLUSION

Accordingly, it is

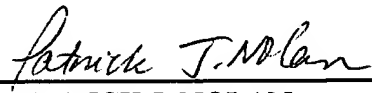
ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed February 28, 2007, defective;
- 2) notify the appellant to submit a “paper” which corrects the Appeal Brief, Summary of Claimed Subject Matter under 37 § 41.37(c)(1)(v);
- 3) acknowledge and consider any “paper” that may be submitted by Appellant in response to the Notice of Non-Compliance to correct the Appeal Brief as required by 37 § 41.37(c)(1)(v);

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- 4) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section of the Examiner's Answer;
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
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PJN/tsj

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